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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,830	11/30/2001	William S. Halliday	154-27883-US	5293

23770 7590 08/06/2003

PAULA D. MORRIS & ASSOCIATES, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON, TX 77042

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,830

Applicant(s)

HALLIDAY ET AL.

Examiner

Philip C Tucker

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46, 50-52, 55-63, 66-70, 73-82, 89-93 and 101 is/are rejected.
- 7) ☒ Claim(s) 47-49, 53, 54, 64, 65, 71, 72, 83-88, 94-100 and 102-113 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 102 – 118 have been renumbered 97-113.

2. Claim 83 is objected to because of the following informalities: The lines split at the 5 and 0, it is thus not clear that applicant is claiming 50. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 73-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 73, 74, 77 and 78 teach "said third quantity" for which there is no antecedent basis. Dependent claims fall herewith.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-37 and 57-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Conner (US 6131661).

Conner teaches a filtercake forming composition which comprises a calcium bromide weighting agent, suspending agents such as xanthan and starch, and sized marble (calcium carbonate). See examples. Applicants intended use as a pill does not distinguish over the art of record (In re Pearson 181 USPQ 641).

7. Claims 1-15, 18-20, 24-26, 29-31, 34-36, 57, 60, 89-93 and 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Brothers et al (6561273).

Brothers teaches a fluid loss composition for sealing which comprises a weighting agent barite, a clay suspending agent such as bentonite or attapulgite, and calcium carbonate (see examples and claim 15). . Applicants intended use as a pill does not distinguish over the art of record (In re Pearson 181 USPQ 641).

Art Unit: 1712

8. Claims 1-15, 18-20, 24-26, 29-31, 34-36, 57 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayberry (US 2003/0029616 A1).

Mayberry teaches a plugging fluid for wellbores which comprises a hydroxyethyl cellulose suspending agent, and magnesium oxide and calcium carbonate which are acid soluble particles, and which can act as weighting agents (see paragraphs 0026 – 0027). . Applicants intended use as a pill does not distinguish over the art of record (In re Pearson 181 USPQ 641).

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Manulik (5353874).

Manulik teaches a slurry of an acid soluble mineral fiber which is used as a blocking agent downhole (see Example 1). Applicants intended use as a pill does not distinguish over the art of record (In re Pearson 181 USPQ 641).

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Corley (4422948).

Corley teaches a fluid loss pill which comprises acid soluble flakes, fibers and granules (see abstract and column 4, lines 27-34).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1712

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-15, 18-20, 24-26, 29-31, 34-36, 38-46, 50-52, 55-57, 60, 63, 66-70, 73, 74, 81 and 82 rejected under 35 U.S.C. 103(a) as being unpatentable over Corley (4422948).

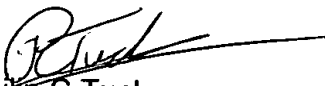
Corley teaches a drilling fluid or fluid loss pill which comprises acid soluble flakes, fibers and granules, such including calcium carbonate and mineral fibers (see abstract, claims and column 4, lines 27-34). Corley teaches that the mud used would contain many well known additives (column 4, lines 48-49). Corley differs from the present invention in that a weighting agent is not specifically disclosed in a composition. However, weighting agents such as barite, zinc or calcium salts are universally used to weight drilling fluids and pills at levels of 9 pounds per gallon or greater, in order to suspend solids within the mud. It would be obvious to one of ordinary skill in the art to use weighting agents within the fluids of Corley, particularly in view of the teaching of Corley that well known additives may be used in the muds.

13. Claims 47-49, 53, 54, 64, 65, 71, 72, 83-88, 94-100 and 102-113 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 703-308-0529. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2857
August 1, 2003